

REMARKS

Claim 12 is amended hereby. Claims 1 - 12 and 14 - 18 are pending.

For the record, Applicants believe that the "Facsimile Form" attached to the Restriction Requirement dated October 1, 1998, is somewhat misleading. Applicants had every intention of traversing the requirement, and stated on the form that the election was traversed. It was thought, although mistakenly, that the form made the response akin to a telephone restriction and that the opportunity to file a complete traversal would follow. There certainly is not enough room on the form to do so. This office will not use the facsimile response form again.

The objection to claim 12 is moot in view of the above amendment.

Claims 1 - 3, 6 - 8, 12 and 15 - 17 were rejected under 35 USC 112, second paragraph, for indefiniteness. This rejection is respectfully traversed.

The claims are considered clear and definite as to their metes and bounds. The percent homology is just that - it does not matter what "algorithm" one uses to determine the percent homology. An example of an algorithm is given at page 10, first paragraph of the specification, PCGENE. The homology is taught as being calculated as the percentage of identical residues in an alignment with the sequence according to the invention; gaps are allowed for maximum alignment. So the specification has a clear teaching as to how to determine sequence identity. To restrict the claims to this particular algorithm would lead to unnecessary, undesirable and unfounded limitation. For one skilled in the art, 80% identity is a clear and defined feature that needs no further explanation; in case of doubt, one could fall back on the PCGENE algorithm.

Accordingly, reconsideration and withdrawal of this rejection are deemed appropriate.

Claims 1 - 8 and 15 - 17 were rejected under 102(e) over Kausch et al. This rejection is respectfully traversed.

Kausch relates to a method for the isolation and sorting of biological material such as chromosomes and/or segments of chromosomes. The method is considered as an alternative to flow cytometry. Kausch teaches that this sorting method can be used to obtain large amounts of pure chromosomes for various purposes, including library construction and cloning. It furthermore suggests that the sorted material can be used in transformation of host cells or vectors. *This is a very generic teaching.* Kausch differs from the present invention in that it discloses a method for the isolation and sorting of chromosomes in general and is not concerned with the DNA *per se*, whereas the present invention relates to the cloning of a particular DNA and its use in medical research.

The merit of the present invention is the surprising discovery that another ER existed besides the already elucidated ER-alpha. This was not known before. No where does Kausch et al. disclose or suggest the existence of ER-beta, let alone cloning and characterization of DNA encoding this ER-beta. The teaching disclosed in Kausch et al. is nothing more than a general teaching about hypothetical uses of the method and can by no means be interpreted as a specific teaching for the isolation and cloning of ER-beta DNA. If this would be the case, then for the same reason the Maniatis Laboratory Manual of Cloning would have anticipated all nucleotide sequences that have been cloned subsequent to its publication.

With respect to particular teachings of Kausch, Example 1 of Kausch discloses mouse chromosomes. Example 2 concerns the isolation and sorting of human chromosome 1, which does not comprise the DNA encoding ER-beta (this is located on chromosome 14).

Therefore, this rejection should be withdrawn.

Claims 1 - 3, 6 - 8 and 15 - 17 stand rejected under 35 USC 102(a) over Karobio AB. This rejection is respectfully traversed.

This reference was not published prior to Applicants' priority dates of March 26, 1996 and November 22, 1996. The Karobio PCT was published March 13, 1997.

Applicants have perfected their claim for priority and have filed the priority documents with the USPTO, which are both in the English language. Therefore, this application is entitled to these priority dates.

The Karobio PCT is not prior art. Therefore, this rejection should be withdrawn.

Finally, claims 1 - 3, 6 - 8, 12 and 15 - 17 were rejected under 35 USC 103(a) over Karobio AB in view of Evans et al.


For the same reasons given above, the Karobio PCT is not prior art, and so this rejection should be withdrawn.

In view of the remarks above, with the present amendments, it is believed that this application is in condition for allowance. Favorable action is solicited.

Should the Examiner consider that a conference would be helpful in advancing the prosecution of this application, he is invited to contact the undersigned at the number below.

In the event any fees are required with this paper, please charge our Deposit Account No. 02-2334.

Respectfully submitted,

  
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